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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.), A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioners,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

RESPONDENTS' BRIEF IN OPPOSITION TO APPLICATION FOR WRIT OF CERTIORARI.

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RESPONDENTS' BRIEF.

May It Please the Court:

This is an ordinary patent case which involved in the courts below the usual issues of validity and infringement. There are concurrent findings by the courts that claims 2 and 3 of the Nudelman patent in suit are valid and infringed. Unlike *Great A. & P. Tea Co.* v. *Supermarket Equipment Co.*, ... U. S. ..... (No. 32, October Term, 1950, decided December 4, 1950) where there was no finding of any additional or different function performed by the elements of the combination, this case involves a pat-

ented device which the trial court expressly held (R. 118) "involves a *new* principle and function, and achieves a *beneficial* result."* In affirming, the Court of Appeals stated (R. 190) that the patented device was "*diametrically opposed in purpose and function*, having * * * an object entirely different" from the principal prior art patent relied upon to negative validity.

Cases believed to require the denial of the petition are:

Keller v. *Adams-Campbell Co.*, 264 U. S. 314, 319.
Layne & Bowler Corp. v. *Western Well Works*, 261 U. S. 387, 393.
United States v. *McFarland*, 275 U. S. 485.
Southern Power Co. v. *North Carolina Pub. Service Co.*, 263 U. S. 508.
Bodkin v. *Edwards*, 255 U. S. 221, 223.

I.

The Court of Appeals (Circuit Judges OTTO KERNER, F. RYAN DUFFY and WALTER M. LINDLEY), after its own careful examination of the evidence, was convinced that the trial court (Hon. MICHAEL L. IGOE) had before it "adequate substantial evidence to justify its findings" (R. 190). With reference to the findings and the evidence in which they were grounded, the Court said (R. 191):

> "Here the court heard the testimony of a number of witnesses, including that of an expert. It expressly found the expert testimony, in certain respects, unworthy of credit. It saw demonstrations of the various devices in court. It passed upon the credibility of the witnesses. It acquired the knowledge that comes from practical demonstration of the two devices."

The Court of Appeals therefore concluded that to declare the findings clearly erroneous (R. 191):

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* Emphasis in quotations added, except when otherwise indicated.

> "would be to overturn the trial court's decision upon controverted evidence and to usurp its function of passing upon the creditability of witnesses • • •"

It is accordingly plain that the facts were in dispute and that the issue of validity raised by petitioners was contingent upon resolving conflicting testimony.

II.

Petitioners admit (Petition, p. 12) that there is "no conflict of decisions with respect to the patent in suit."

Candor should have also required them to admit that they seek to bring the case to this Court to fight a phantom. The broad issue presented by the petition as being of great public importance is predicated upon an assumption taken by petitioners contrary to the record, and constitutes a misinterpretation and distortion of the opinion of the court below.

There is no basis whatever either in the opinion of the court below or in the particular facts of this case for the contention that the Court of Appeals has rejected the "flash of genius" test of invention as announced by this Court in *Cuno Eng. Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84. Neither that case nor the "flash of genius" test are referred to, expressly or otherwise. One may search the opinion of the court below (R. 188-191) in vain for the perverted view of it presented by petitioners. What the court held was that the Nudelman patent was *not anticipated* and that the conception and production of the Nudelman device was beyond the skill of the mechanic and required *exercise of inventive genius* (R. 190). The facts were said to bring the case within the scope of such cases, *inter alia* as *Paramount Corp.* v. *American Tri-Ergon Corp.*, 294 U. S. 464.

Whether or not the Court of Appeals rejected the *Cuno* test in the earlier cases mentioned in the petition (p. 11), *viz., Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812; *National Slug Rejectors, Inc.* v. *A. B. T. Mfg. Corp.*, 164 F. 2d 333; *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427; *Peckat Mfg. Co.* v. *Jacobs*, 178 F. 2d 794, is, in our submission, most irrelevant here. The Court did not do so in the case at bar. Moreover, if the last three cases were not taken for review (*vide*, 333 U. S. 832; 338 U. S. 870; and 339 U. S. 915), then certainly the opinion in the case at bar, which does not even remotely suggest a rejection of the "flash of genius" test, is not required to be reviewed.

Hence, there are here no questions of importance to the public as distinguished from the parties.

III.

What petitioners really seek is a review in this Court of disputed facts and conflicting testimony; they would have this Court find the facts different from those found by the courts below.

For example, as we now show, in order to agree with petitioners "that invention over the Smith patent (R. 170) is not spelled out by the claims in issue" (Petition, p. 11), it would be necessary for this Court to set aside the trial court's findings that Smith patent No. 2,207,417 (R. 170) "does not, either alone or in combination with other patents, show the device of the Nudelman patent in suit to be lacking in novelty" (F. F. 15, R. 115), as well as to upset the credibility finding that the testimony of petitioners' expert respecting the Smith patent was "lacking in verity" and constituted an "unreasonable distortion of the language of the claim" (F. F. 15(e), R. 116).

The Prior Art Smith Patent Is "Entirely Unlike" Nudelman and "Diametrically Opposed in Purpose and Function." It Neither Anticipates Nor Negatives Invention.

While it is true that Smith stated that a child eating cereal would be interested in the movement of the cereal from the hopper into the bowl (R. 171; Petition, p. 4), it was conceded by petitioners' expert that these references related to a concept "quite different from that of Nudelman" (F. F. 15(d), R. 116), and he conceded that he was unable to find in the Smith patent "any teaching of stimulating and encouraging infants to eat by psychology and mimicry" (*id.*).

Petitioners' expert also admitted (F. F. 15(d), R. 116):

> "that it is contrary to Smith's express teachings to take spoonfuls of mixed cereal and milk from the bowl and put them back into the hopper."

And (*id.*):

> "that there is no suggestion or hint in the Smith patent of such an operation."

There is no evidence that anyone prior to the trial below ever regarded Smith's device as a solution of the feeding problem tackled by Nudelman or even thought of so using it. Smith's application was filed in 1938; his patent issued in 1940. Yet the art was taught absolutely nothing concerning utilitarian educational amusement devices to aid in the feeding of children. Smith's device, hence, fell far short of producing any desirable results. It apparently began and ended its uneventful career in 1938 when the application was filed. It seems to have occurred to no one that this device was the answer to the problem. The testimony of the witnesses Scharie and Eliot (R. 22, 26-27) is to the effect that in 1948—ten years after Smith's application date—there was a crying demand for a device of the

type shown in the Nudelman patent. This historical fact alone compels the conclusions that Smith's device was not used because it was not usable and that it is not identical to Nudelman and will not serve his purpose.

In support of the finding of no anticipation the trial court found (F. F. 15(b), R. 116):

> "It is the avowed purpose of Smith, repeatedly stressed in the patent, to maintain precooked dry cereals in the hopper and bin separated from the milk, thereby to retain original crispness and to aid digestion by more intensive mastication of food. The hopper of Smith was not designed or intended to perform the function of the device shown in the Nudelman patent. Moreover, it is contrary to the express purpose of the Smith device to return food to the hopper from the bowl. The device of the Smith patent has an object in view which is *entirely different* from that of Nudelman. It is used under *radically different conditions* to perform a function *quite different* from that of the Nudelman device, and it employs an *antithetical principle of operation.*"

This finding is well grounded in the evidence. Thus, the Court of Appeals held (R. 190):

> "A careful examination of the evidence is convincing that the trial court had before it adequate substantial evidence to justify its findings."

The "Achilles heel" of the comparison found at page 15 of the petition is found in the unwarranted liberties taken by petitioners' expert with the words "body portion" of the patent claims and in his distorted appraisal of the Smith structure. This expert read the claims as though they existed *in vacuo;* he shut his eyes to the Nudelman disclosure and gave to the words of the claims any meaning which pleased him.

The "body portion" called for in Nudelman's claim and which is required to be *placed adjacent the exterior of the*

bowl is the body 10. This is the *main, central, and principal* portion of the pig, and is necessarily so both in the light of the disclosure and in accordance with ordinary dictionary definition.* From Nudelman's main body portion an auxiliary or smaller portion projects inwardly or into the bowl.

On the other hand, the main, central or principal portion of Smith's hopper, *i. e.*, the "body portion" thereof, is found *disposed on the interior of the bowl* with a very small portion of the wall thereof projecting above the bowl rim. It is a perversion not only of the English language, but of Smith's structure as well, to label this small portion of the wall 12 and the beaded projection 23 the "body portion."

The testimony of petitioners' expert (and with it his comparison exhibit found at page 15 of the petition) was rejected by the trial court in the following finding (R. 116):

> "The testimony of defendants' patent expert in which he applied the language of claim 2 of the Nudelman patent in suit to the structure of Fig. 4 of the Smith patent *must be rejected as lacking in verity.* This testimony constituted an unreasonable distortion of the language of the claim, and wholly failed to take into account the meaning and sense of the language, the disclosure of the patent in suit and its objects and purposes. Read upon the device of Fig. 4 of the Smith patent, claim 2 of the Nudelman patent in suit ceases to represent the invention of Nudelman."

In order to make Smith like Nudelman, it is necessary to change, redesign and *relocate* essential parts of the hopper as well as to impress new and different functions upon

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* Webster's New International Dictionary defines "body" *inter alia* as "The Trunk, or main part (esp. of a person, animal, or plant), as distinguished from the limbs and the head; the main, central, or principal part, as of a tree, army, country, structure, building, etc."

them, *i. e.*, employ them in a manner never contemplated,—indeed, *inconsistent with Smith's disclosure*, for it is "diametrically opposed in purpose and function," as was stated by the Court of Appeals (R. 190). A prior device not designed, nor adapted, nor actually used for the performance of the function of the patented device does not anticipate (*Topliff* v. *Topliff*, 145 U. S. 156, 161).

Furthermore, the evidence in this case dicloses all of the criteria or symptoms* of invention.

The factual historical background of the Nudelman invention is covered by a finding of fact which petitioners do not challenge. Thus, there was a substantial demand for a satisfactory device to solve a long-standing problem (F. F. 7, 8, 9, R. 112-113). Defendant Eliot, who had been in the business of manufacturing and selling related items for a number of years prior to 1948, found, on a survey conducted by him, that there was a market in 1948 for a device of the type shown in the patent in suit. As of August, 1948, he estimated that such a device could be sold and distributed in "large numbers," about 90,000 a month (R. 26-27), and he thought the demand was sufficient enough to warrant an investment of $55,000.00 (R. 25-27).

The problem was solved by Nudelman (F. F. 7, R. 112). His device which solved the problem and satisfied the demand was found by the trial court to be "unique" and "ingenious" and to constitute a "genuine improvement over any prior device" (F. F. 10, R. 113). Petitioners have characterized the infringing device (F. F. 10, R. 113) as "unusual" and *sparked* with "cleverness, color and imagination"—a "frank and apparently a just tribute" (cf. *Potts* v. *Creager*, 155 U. S. 597, 610).

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* Regardless of precise and comprehensive definitions of the test and whether we speak in terms of "inventive genius", "intuitive genius", "genius or invention" or "flash of creative genius."

Conclusion.

The decision below is correct. It is in accord with applicable decisions of this Court and is not in conflict with decisions of other courts of appeals either as to the patent in suit or as to any rules of decision. This case, moreover, does not involve any principles or issues settlement of which is of importance to the public as distinguished from the parties.

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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